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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,695	11/07/2001	Gil Enos	37610-6049	9629
33123	7590	01/27/2006	EXAMINER	
HELLER EHRLMAN LLP 4350 LA JOLLA VILLAGE DRIVE #700 7TH FLOOR SAN DIEGO, CA 92122			GLASS, RUSSELL S	
		ART UNIT	PAPER NUMBER	3626

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/005,695	ENOS ET AL.	
	<b>Examiner</b> Russell S. Glass	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 November 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/29/03</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Objections***

1. Claim 16 objected to because of the following informalities: Line 10 fails to make sense. Examiner believes that line 10 should read: and wherein said determined MG formulary is based on said received MCO formulary.

### ***Claim Rejections - 35 USC § 112***

2. **Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In particular, all rejected claims fail to particularly point out and distinctly claim who or what is performing method steps. For example, claim 1 fails to describe who or what is "receiving a formulary" and "generating a personalized physician-specific prescription pad".

The gerund phrases comprising the method steps in claims 2-17 are replete with similar ambiguities and render the claims vague and indefinite for the same reasons and in the same manner as that provided in the rejection of claim 1.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**3. Claims 1-11, 17-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayaud, (U.S. 5,845,255).**

**4. As per claim 1, Mayaud discloses a method of providing medical prescription service, the method comprising:**

(a) receiving a formulary for a physician wherein said formulary is stored in a data store, (Mayaud, col. 8, lines 1-32)(disclosing a physician receiving information from a data list of formularies);  
(b) generating a personalized physician-specific prescription pad using said received formulary, (Mayaud, col. 7, lines 30-67; col. 8, lines 1-32; col. 9, lines 65-67, col. 12, lines 35-56 ) (disclosing an adaptive method for receiving a formulary and generating a personalized physician-specific prescription pad from the formulary information).

**5. As per claim 2, Mayaud discloses a method as defined in claim 1 wherein said received formulary for said physician may take into account the physician's prescribing habits, the formularies of managed care organizations (MCOs) across the physician's patient base, the drugs within the MCO formulary which are likely to be approved by the MCO, and the formulary of the medical groups to which the physician belongs, (Mayaud, col. 5, lines 33-43, 48-50, 62-64; col. 7, lines 30-67; col. 8, lines 1-32; col. 9, lines 65-67; col. 12, lines 35-56; col. 13, lines 13-18, 40-44) (disclosing an adaptive**

method for receiving a formulary and generating a personalized physician-specific prescription pad, taking into account the specific preferences of the drug benefit management company and the physician that are relative to the patient's condition and the physician's specialty).

6. As per claim 3, Mayaud discloses a method further comprising: providing a preview of said prescription pad, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21).
7. As per claim 4, Mayaud discloses a method wherein the preview of said prescription pad is provided over a computer network connection, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21).
8. As per claim 5, Mayaud discloses a method wherein said formulary is received over a computer network data connection, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21).
9. As per claim 6, Mayaud discloses a method further comprising: sending a message informing a user of said generation of said prescription pad, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21)(see specifically prescribing zone 44 wherein virtual prescription pad is virtually generated and displayed, thus effectively sending a message informing a user of said generation of said prescription pad).

10. As per claim 7, Mayaud discloses a method further comprising: receiving approval of said generated personalized prescription pad, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21)(send Rx button for output to pharmacy or printer is a method of receiving approval from user).

11. As per claim 8, Mayaud discloses a method further comprising: receiving an alert-triggering information that relates to the formulary listed in said generated prescription pad, (Mayaud, col. 23, lines 19-39).

12. As per claim 9, Mayaud discloses a method further comprising: sending alert communication to a user based on said alert-triggering information, (Mayaud, col. 23, lines 19-39).

13. As per claim 10, Mayaud discloses a method wherein said alert communication indicates that said personalized prescription pad previously generated for said physician has to be updated, (Mayaud, col. 15, lines 48-52; col. 20, lines 32-36; col. 23, lines 19-39)(disclosing a method of automatically updating and/or requiring that the personalized prescription pad be updated because the system prevents prescribing an drug subject to an alert communication).

14. As per claim 11, Mayaud discloses a method further comprising:

creating a new personalized prescription pad for said physician based on said alert-triggering information, (Mayaud, col. 15, lines 48-52; col. 20, lines 32-36; col. 23, lines 19-39).

15. As per claim 18, Mayaud discloses a computer system that provides medical prescription services to physicians, the system comprising:

- (a) an RxIQ Datamart that stores, processes, collects, and combines formulary information, including formulary for physicians, medical groups, and managed care organizations, and user information, (Mayaud, col. 46, lines 23-31; col. 47, lines 29-46)(host computer facility is equivalent to an RXIQ Datamart because it performs an identical function in substantially the same way and produces substantially the same results),
- (b) a Prescriber Portal that enables users to provide formularies and physician-specific information, including prescribing habits, that are then stored in said RxIQ Datamart, (Mayaud, col. 7, lines 30-45; col. 8, lines 1-9); and
- (c) an eScriptPad Configurator that creates personalized physician-specific prescription pad called eScriptPad based on formularies and physician-specific information available, (Mayaud, col. 8, lines 34-48; col. 9, lines 65-67; col. 45, lines 35-47).

16. As per claim 19, Mayaud discloses a system wherein the eScriptPad Configurator enables a user to preview the eScriptPad prescription pad and enables

revisions and inputs to said prescription pad, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21).

17. As per claim 20, Mayaud discloses a system wherein the preview of eScriptPad prescription pad is provided over a computer network connection, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21; col. 46, lines 1-5).

18. As per claim 21, Mayaud discloses a system wherein the user input and revisions are received over a computer network data connection, (Mayaud, col. 45, lines 35-47).

19. As per claim 22, Mayaud discloses a system further comprising: an Rx Alert Service that receives alert-triggering information and sends alert-triggering communication to the appropriate user, (Mayaud, col. 23, lines 19-39).

20. As per claim 23, Mayaud discloses a system wherein said alert-triggering communication indicates that an eScriptPad prescription pad created by said eScriptPad Configurator needs to be updated, (Mayaud, col. 15, lines 48-52; col. 20, lines 32-36; col. 23, lines 19-39)(disclosing a method of automatically updating and/or requiring that the personalized prescription pad be updated because the system prevents prescribing an drug subject to an alert communication).

21. As per claim 24, Mayaud discloses a system further comprising:

a DecisionIQ Prescription Analyzer that processes information retrieved from the RxIQ Datamart and generates reports, (Mayaud, col. 13, lines 19-47).

22. As per claim 25, Mayaud discloses a system wherein said report is a prescription exception report, (Mayaud, col. 12, lines 34-col. 13, line 12; col. 36, lines 1-65)(user-adaptive reporting functions contain information is equivalent to a prescription exemption report because it performs an identical function in substantially the same way and produces substantially the same results, i.e., it reports whether or not the user prescribed a formulary drug).

23. As per claim 26, Mayaud discloses a computer system that provides medical prescription services to physicians, the system comprising:

- (a) a computing means that receives input from network nodes, (Mayaud, col. 46, lines 23-31; col. 47, lines 29-46);
- (b) a store and processing means that stores, processes, collects, and combines formulary information, including formulary for physicians, medical groups, and managed care organizations, and user information, (Mayaud, col. 46, lines 23-31; col. 47, lines 29-46),
- (c) an input receiving means that enables users to provide formularies and physician-specific information, including prescribing habits, that are then stored in said RxIQ Datamart, (Mayaud, col. 8, lines 1-9, 24-33, col. 45, lines 35-47); and

(d) a pad configuration means that creates personalized physician-specific prescription pad called eScriptPad based on formularies and physician-specific information available, (Mayaud, col. 8, lines 34-48; col. 9, lines 65-67; col. 45, lines 35-47).

24. As per claim 27, Mayaud discloses a physician-specific prescription pad based from a process in which a formulary for a physician is received and wherein said formulary takes into account the physician's prescribing habits, the formularies of managed care organizations (MCOs) across the physician's patient base, the drugs within the MCO formulary which are likely to be approved by the MCO, and the formulary of the medical groups to which the physician belongs, (Mayaud, col. 5, lines 40-48, col. 7, lines 13-20; col. 8, lines 1-8, 24-33; col. 9, lines 65-67; ).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud, (U.S. 5,845,255).**

26. As per claim 12, Mayaud discloses a method, further comprising:

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- (a) receiving a formulary wherein said formulary is stored in a data store, (Mayaud, col. 8, lines 1-32)(disclosing a physician receiving formulary information from a data list of formularies);
- (b) receiving physician information for said physician wherein said physician information is stored in a data store, (Mayaud, col. 8, lines 1-32) (patterns, habits and other historical, user-specific information are considered to be physician information); and
- (c) wherein said received formulary for said physician from which said personalized prescription pad is generated, including user revisions, if any, and based on said physician information, including said physician's practice area, (Mayaud, col. 5, lines 33-43, 48-50, 62-64; col. 7, lines 30-67; col. 8, lines 1-32; col. 9, lines 65-67; col. 12, lines 35-56; col. 13, lines 13-18, 40-44) (disclosing an adaptive method for receiving a formulary and generating a personalized physician-specific prescription pad, taking into account the specific preferences of the drug benefit management company and the physician that are relative to the patient's condition and the physician's specialty).

Mayaud fails to disclose receiving a formulary for a medical group upon which a formulary for a physician is based on. However, Mayaud discloses personalizing the invention for users, and that a group practice can be a user, (Mayaud, col. 7, lines 13-20). Mayaud further discloses presenting intelligent data lists to users, organized in multiple hierarchies, including information from all formularies, (Mayaud, col. 8, lines 1-32).

It would be obvious to one of ordinary skill in the art at the time of the invention to use Mayaud to create a physician formulary based upon the physician's medical group formulary, and use the physician formulary to generate a prescription pad. The motivation would be to minimize data entry, (Mayaud, col. 4, lines 48-55).

27. As per claim 13, Mayaud discloses a method further comprising:  
receiving an alert-triggering information, (Mayaud, col. 23, lines 19-39).

The statement of obviousness and motivation to combine the teachings of Mayaud is as provided in the rejection of claim 12 and incorporated herein by reference.

28. As per claim 14, Mayaud discloses a method wherein said alert-triggering information is a change to said formulary from said medical group, (Mayaud, col. 7, lines 13-20; col. 15, lines 48-52; col. 20, lines 32-36; col. 23, lines 19-39)(disclosing a method of automatically updating and/or requiring that the personalized prescription pad be updated because the system prevents prescribing a drug currently in a formulary, that is subject to an alert communication. This is considered to be a change to said formulary of the group practice).

The statement of obviousness and motivation to combine the teachings of Mayaud is as provided in the rejection of claim 12 and incorporated herein by reference.

29. As per claim 15, Mayaud discloses a method further comprising:

sending alert communication to a user based on said alert-triggering information, (Mayaud, col. 23, lines 19-39).

The statement of obviousness and motivation to combine the teachings of Mayaud is as provided in the rejection of claim 12 and incorporated herein by reference.

30. As per claim 16, Mayaud discloses a method, further comprising:

- (a) receiving formulary for at least one MCO and storing said MCO formulary in a data store, (Mayaud, col. 35, lines 36-50); and
- (b) determining an MG formulary based on MCO formularies, including user revisions, if any, (Mayaud, col. 7, lines 13-20; col. 35, lines 36-50; col. 15, lines 48-58)(a group practice is considered to be an MG, a prescription benefits management company is considered to be an MCO, and updates would include user revisions), and
- (c) wherein said determined MG formulary is based on said received MCO formulary, (Mayaud, col. 5, lines 33-43, 48-50, 62-64; col. 7, lines 30-67; col. 8, lines 1-32; col. 9, lines 65-67; col. 12, lines 35-56; col. 13, lines 13-18, 40-44) (disclosing an adaptive method for receiving a formulary and generating a personalized physician-specific prescription pad, taking into account the specific preferences of the drug benefit management company and the physician that are relative to the patient's condition and the physician's specialty).

Mayaud fails to disclose receiving a formulary for MCO upon which a formulary for medical group is based on. However, Mayaud discloses personalizing the invention for users, and that a group practice can be a user, (Mayaud, col. 7, lines 13-20).

Mayaud further discloses presenting intelligent data lists to users, organized in multiple hierarchies, including information from formularies and including the preferences of a drug benefit management company, (Mayaud, col. 5, lines 40-43; col. 8, lines 1-32)(an MCO is considered to be a drug benefit management company).

It would be obvious to one of ordinary skill in the art at the time of the invention to use Mayaud to create an MG formulary based upon the MCO formulary, and use the physician formulary to generate a prescription pad. The motivation would be to reduce costs, (Mayaud, col. 4, lines 26-32).

31. As per claim 17, Mayaud discloses a method further comprising:

- (a) receiving actual prescription filled information for said physician, (Mayaud, col. 13, lines 25-47); and
- (b) generating a prescription analysis for said physician, (Mayaud, col. 13, lines 25-47) (reporting functions are considered to be analysis).

The statement of obviousness and motivation to combine the teachings of Mayaud is as provided in the rejection of claim 12 and incorporated herein by reference.

### ***Conclusion***

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: Edelson et al, (U.S. 5,737,539); Albaum et al, (U.S. 5,758,095); Ilsen et al., (U.S. 6,757,898); Pack-Harris, (U.S. 6,195,612); Denny, (U.S. 6,687,676); Kaafarani et al., (U.S. 6,871,783); and, Colon et al., (5,991,731).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RSG  
1/5/06



C. LUKE GILLIGAN  
PATENT EXAMINER